

**REMARKS**

Applicants respectfully acknowledge receipt of the Office Action mailed December 17, 2004.

In the Office Action, the Examiner: (1) objected to the specification; (2) rejected claim 9 under 35 U.S.C. §112, first paragraph; (3) rejected claims 4, 8, and 9 under 35 U.S.C. §112, second paragraph; (4) rejected claims 1-4, 8, and 9 under 35 U.S.C. §102(b) as being anticipated by *Arndt et al.* (U.S. Patent No. 6,459,130); (5) rejected claims 5 and 6 under 35 U.S.C. §103(a) as being unpatentable over *Arndt et al.* in view of *Hurt et al.* (U.S. Pub. No. 2003/0007749); and (6) rejected claim 7 under 35 U.S.C. §103(a) as being unpatentable over *Arndt et al.* in view of *Kwon et al.* (U.S. Patent No. 6,518,660).

By this amendment, Applicants propose to submit a substitute specification, amend the abstract, amend claim 1, cancel claims 2-9, and add new claims 10-14 to better define the invention. Claims 1 and 10-14 remain pending in this application. Of these claims, claim 1 is independent.

The originally-filed specification, claims, abstract, and drawings fully support the substitute specification, amendments to the abstract and claim 1, and the addition of new claims 10-14. No new matter has been introduced.

Based on the foregoing amendments and remarks, Applicants respectfully traverse each of the above objections and rejections and request reconsideration for the reasons that follow.

**I. OBJECTION TO THE SPECIFICATION**

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner asserts “the specification does not disclose that a cavity is within a cavity as recited in claim 4.” (*Office Action*, p. 2, ll. 6-9).

Applicants have canceled claim 4. Accordingly, the rejection is moot and reconsideration is requested.

**II. 35 U.S.C. §112, FIRST PARAGRAPH REJECTION**

Claim 9 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner asserts “the claim(s) contains subject matter which was not described in the specification...the claim includes the limitation of ‘the same horizontal datum.’” (*Office Action*, p. 2, ll. 18-25).

Applicants have canceled claim 9. Accordingly, the rejection is moot and reconsideration is requested.

**III. 35 U.S.C. §112, SECOND PARAGRAPH REJECTION**

Claims 4, 8, and 9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner asserts “Claim 4 recites the limitation ‘a cavity provided within the cavity’ in line 2...Claim 8 recites the limitation ‘the soldering terminals are right at the bottom of the package’...Claim 9 recites the limitation ‘the soldering terminals are flat and have the same horizontal datum as the encapsulation material.’” (*Office Action*, p. 3, ll. 4-18).

Applicants have canceled claims 4, 8, and 9. Accordingly, the rejection is moot and reconsideration is requested.

#### **IV. 35 U.S.C. §102(b) REJECTION OF CLAIMS 1-4, 8, AND 9**

Applicants submit that currently amended independent claim 1 is patentably distinguishable under 35 U.S.C. §102 over the cited references, including *Arndt*, *Hurt*, *Kwon*, and the other art of record. The cited prior art fails to disclose or suggest each element of the invention recited in independent claim 1. In particular, the applied references, taken alone or in combination, at least fail to teach or suggest an optoelectronic component based on a surface mount technology, said optoelectronic component comprising: an electrically conductive frame to form a base for an assembly; at least one optoelectronic chip mounted on said base; an electrical connection between said optoelectronic chip and said electrically conductive frame by wiring means; and soldering terminals which are part of said electrically conductive frame and are exposed at bottom and side portions of said component; wherein said electrically conductive frame is encapsulated with a translucent material to enable optical radiation to be transmitted or received via said optoelectronic component; and wherein said soldering terminals do not extend beyond an outline of said encapsulation material.

*Arndt* teaches an optoelectronic semiconductor component comprising external connections 11, 12 of the chip carrier part 2 and of the connection part 10. (*Arndt*, col. 2, ll. 65-66). *Arndt*, however, teaches “each [connection] project[s] from the encapsulation 3 on opposite sides and are bent outside the encapsulation 3, downwards and then inwards towards the centre of the encapsulation” (emphasis added). (*Id.*, col. 2, line 66 – col. 3, line 2 and FIGS 1A-1C). Accordingly, *Arndt*

necessarily fails to teach or suggest the claimed combination including “wherein said soldering terminals do not extend beyond an outline of said encapsulation material,” as recited in proposed amended claim 1. In addition, *Hurt* and *Kwon* similarly fail to teach or suggest the claimed combination including “wherein said soldering terminals do not extend beyond an outline of said encapsulation material,” as recited in proposed amended claim 1.

Accordingly, *Arndt*, *Hurt*, and *Kwon*, either alone or in combination, do not disclose or suggest the invention recited in independent claim 1. In particular, as noted above, none of these references teaches or suggests “wherein said soldering terminals do not extend beyond an outline of said encapsulation material.” For at least these reasons, Applicants request that independent claim 1 be allowed.

Applicants have canceled dependent claims 2-4, 8, and 9. Accordingly, the rejection is moot and reconsideration is requested.

Moreover, new claims 10-14 are allowable at least due to their dependence from independent claim 1. In addition, at least some of the dependent claims recite unique combinations that are neither disclosed nor suggested by the cited art, and therefore some also are separately patentable.

#### **V. 35 U.S.C. §103(a) REJECTION OF CLAIMS 5-7**

Claims 5 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Arndt et al.* in view of *Hurt et al.* Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Arndt et al.* in view of *Kwon et al.* Applicants respectfully traverse the rejections.

Applicants have canceled claims 5-7. Accordingly, the rejection is moot and reconsideration is requested.

## **VI. CONCLUSION**

Applicants respectfully submit that independent claim 1 is in condition for allowance. In addition, claims 10-14 are in condition for allowance at least due to their dependence from claim 1.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: March 17, 2005

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**Attachments:** A marked-up version of the substitute Specification  
A clean copy of the substitute Specification